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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/875,530   | 06/06/2001  | Hisashi Tanaka       | 14684               | 6951             |
| 23389  | 7590        | 01/26/2006           | EXAMINER            |                  |
| SCULLY SCOTT MURPHY & PRESSER, PC<br>400 GARDEN CITY PLAZA<br>SUITE 300<br>GARDEN CITY, NY 11530 |             |                      | POND, ROBERT M      |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3625                |                  |

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/875,530 | <b>Applicant(s)</b><br>TANAKA ET AL. |  |
|                              | <b>Examiner</b><br>Robert M. Pond    | <b>Art Unit</b><br>3625              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2-4,6,8-11,13-15,20-25,27-29 and 34-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4,6,8-11,13-15,20-25,27-29 and 34-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

The Applicant amended claims 2, 13, and 27. All pending claims (2-4, 6, 8-11, 13-15, 20-25, 27-29, and 34-37) were examined in this final office action necessitated by amendment.

### ***Response to Arguments***

Applicant's arguments filed 25 March 2005 have been fully considered but they are not persuasive. Boesch discloses the customer has option of changing the customer's information (please note: changing customer information previously stored (e.g. does not agree with server's selection, contains an error); customer can change the previously stored shipping address to enter a new shipping address; can have a plurality of possible entries (see at least col. 9, line 62 through col. 10, line 16). The Applicant's arguments cite shipping address changing which is what Boesch discloses. Boesch further discloses having a plurality of possible entries into the same information block with a designated preferred entry. To be able to alter alternate pieces of information stored by the invention of Boesch in the same block, the user must be able to access it.

A customer registers customer information that is stored permanently in remote server storage whereby any subsequent access results in the server recognizing the customer in advance of subsequent purchases. A customer has

the option of changing the customer information (e.g. does not agree with server's selection, contains an error). For example, the customer can change the previously stored shipping address to enter a new shipping address. The customer action is designating alternative pieces of information used to complete the purchase.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- 1. Claims 2-4, 6, 8-11, 13-15, 20-25, 27-29, and 34-37 are rejected under 35 USC 102(e) as being anticipated by Boesch (Paper #2, patent number 6,092,053).**

Boesch teaches all the limitations of Claims 2-4, 6, 8-11, 13-15, 20-25, 27-29, and 34-37. For example, Boesch discloses a method of electronic commerce allowing consumers to purchase items over a network and merchants to receive payment information relating to the purchases (please see at least abstract; Fig. 1 (100, 102, 120, 122, 160); col. 2, line 10 through col. 4, line 62). Boesch further discloses:

- Storing customer information entered in a plurality of terminals; in advance: customer information is entered by each customer on respective customer computer (see at least Fig. 1(100, 102, 104)); customer registering resulting in customer information being stored permanently in remote server storage; subsequent access results in server recognizing the customer, the customer already being known to the system in advance of subsequent accesses; customer information being, but not limited to: customer's name, billing address, shipping address, credit card number, email address, telephone numbers, fax numbers, and user preferences (see at least Fig. 1 (146); col. 5, lines 35-37; col. 6, lines 20-34).
- Designating a commodity provided by commodity provision means: merchant server, CIS, network (see at least col. 3, lines 20-54).
- Displaying the customer information: displays graphic of customer wallet on customer computer via web browser (see at least col. 3, lines 37-43).
- Designating by the user alternative pieces of information; storing: customer has option of changing the customer's information (please note: changing customer information previously stored (e.g. does not agree with server's selection, contains an error); customer can change the previously stored shipping address to enter a new shipping address; can have a plurality of possible entries (see at least col. 9, line 62 through col. 10, line 16). Please note: customer action is designating alternative pieces of information.

- Customer information pertaining to the designated commodity: e.g. credit card number, address, shipping address (see at least col. 3, lines 54-61).
- Storing; storage means: databases, data logs, data structures (see at least col. 3, lines 18-19; col. 12, lines 16-18).
- Modules: software, pages, forms (please note examiner's interpretation: pages and forms are examples of display modularity as executed by software) (see at least col. 3, line 62-65).

Pertaining to system claims 13-15, 20-25, 27-29, and 34-37

Rejection of claims 13-15, 20-25, 27-29, and 34-37 is based on the same rationale as noted above.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

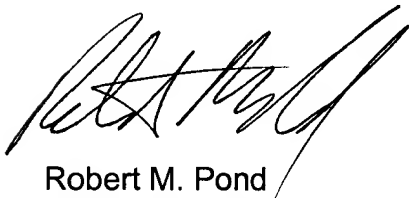
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. M. Pond', is written over a horizontal line.

Robert M. Pond  
Primary Examiner  
January 23, 2006